

Docket No. 22HF-165423-912

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Summit Entertainment, LLC

Serial No: 85/813,593

Filed: January 1, 2013

Class: 9

Mark: INSURGENT

Examiner:

Mark Sparacino

Law Office: 103

APPLICANT'S APPEAL BRIEF

10-30-2015

TABLE OF CONTENTS

	<u>Page</u>
A. PRELIMINARY STATEMENT	1
B. STATEMENT OF FACTS	2
1. INFORMATION ABOUT THE PARTIES	2
2. PROCEDURAL BACKGROUND.....	2
C. THE EXAMINER’S REFUSAL TO REGISTER APPLICANT’S MARK ON THE BASIS OF LIKELIHOOD OF CONFUSION SHOULD BE WITHDRAWN	8
1. THE STANDARD FOR DETERMINING LIKELIHOOD OF CONFUSION.....	8
2. THE OFFICE HAS A HISTORY OF REGISTERING NUMEROUS INSURGENT AND INSURGENT-RELATED MARKS.....	8
3. THE MARKS ARE DISTINGUISHABLE IN APPEARANCE, SOUND, CONNOTATION AND COMMERCIAL IMPRESSION AND THE DIFFERENT CONTEXTS IN WHICH THE MARKS ARE ENCOUNTERED	12
A. APPLICANT’S MARK AND THE CITED MARK ARE ENCOUNTERED IN DIFFERENT CONTEXTS	12
B. APPLICANT’S MARK AND THE CITED MARK ARE DIFFERENT IN APPEARANCE, SOUND, CONNOTATION AND COMMERCIAL IMPRESSION	19
4. APPLICANT’S GOODS AND THE GOODS IN REGISTERED IN CONNECTION WITH THE CITED MARK ARE NOT RELATED	20
5. REGISTRANT’S CUSTOMERS EXERCISE CARE	24
6. THERE IS NO EVIDENCE THE CITED MARK IS FAMOUS	25
D. CONCLUSION.....	26

TABLE OF AUTHORITIES

	Page(s)
<u>Cases</u>	
<i>Colgate-Palmolive Co. v. Carter-Wallace, Inc.</i> 167 USPQ 529 (CCPA 1970)	20
<i>Colgate-Palmolive v. J.M.D. All-Star Import</i> 486 F. Supp.2d 286 (S.D.N.Y. 2007).....	19
<i>Continental Plastic Containers v. Owens Brockway Plastic Products, Inc.</i> 141 F.3d 1073 (Fed. Cir. 1998).....	24
<i>In re Digirad Corp.</i> 45 USPQ2d 1841 (TTAB 1998)	24
<i>In re E.I. Du Pont de Nemours & Co.</i> 177 USPQ 563 (CCPA 1973)	8, 19, 24
<i>Echo Drain v. Newsted</i> 307 F. Supp.2d 1116 (C.D. Cal. 2003)	19
<i>Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.</i> 954 F.2d 713 (Fed. Cir. 1992).....	24
<i>First Sav. Bank, F.S.B. v. First Bank Sys.</i> 101 F.3d 645 (10th Cir. 1996)	9
<i>General Mills, Inc. v. Kellogg Co.</i> 824 F.2d 622 (8th Cir. 1987)	9
<i>Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.</i> 952 F. Supp. 1084 (D.N.J. 1997)	21
<i>In re i.am symbolic, llc,</i> 2015 TTAB LEXIS 369, *12	22, 23
<i>In re Thor Tech, Inc.</i> 113 USPQ.2d 1546, 1549 (TTAB 2015)	10, 11
<i>Kayser-Roth Corp. v. Morris, Co., Inc.</i> 164 USPQ 153 (TTAB 1969)	20
<i>Keebler Co. v. Associated Biscuits, Ltd.</i> 207 USPQ 1034 (TTAB 1980)	9, 10, 11

<i>Local Trademarks, Inc. v. Handy Boys Inc.</i> 16 USPQ.2d 1156, 1158 (TTAB 1990)	12
<i>M2 Software, Inc. v. M2 Communications, Inc.</i> 450 F.3d 1378 (Fed. Cir. 2006).....	25
<i>Recot, Inc. v. Becton</i> 214 F.3d 1322 (Fed. Cir. 2000).....	8, 25
<i>Sand Hill Advisors, LLC v. Sand Hill Advisors, LLC</i> 680 F. Supp.2d 1107 (N.D. Cal. 2010)	9
<i>Sands, Taylor & Wood Co. v. Quaker Oats Co.,</i> 978 F.2d 947, 957 & n.12 (7th Cir. 1992)	23
<i>Shen Mfg. Co. v. Ritz Hotel Ltd.</i> 393 F.3d 1238 (Fed. Cir. 2004).....	12
<i>Sunenblick v. MCA Records, Inc.</i> 895 F. Supp. 616 (S.D.N.Y. 1995)	21
<i>Sweats Fashions Inc. v. Pannill Knitting Co. Inc.</i> 833 F.2d 1560 (Fed. Cir. 1987).....	10
<i>Top Tobacco LP v. North Atlantic Operating Co.,</i> 101 USPQ.2d 1163, 1173	11
<u>Other Authorities</u>	
J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> (Fourth Ed.) § 19:75 at 19-230	8
<i>McCarthy</i> § 23:48 at 23-203	8
TMEP § 1207.01	8
TMEP § 1207.01(a)(i).....	12

Applicant Summit Entertainment, LLC (“Applicant”) hereby submits its brief in support of its appeal of the Examiner’s refusal to register Applicant’s trademark INSURGENT under § 2(d) of the Trademark Act on the ground that it is likely to cause confusion, to cause mistake, or to deceive with U.S. Registration No. 4,392,625 for INSURGENCY for “computer game software for personal computers and home video game consoles” in Class 9 owned by Jeremy A. Blum (“Cited Mark”). The goods at issue are “computer games, namely computer game cartridges, cassettes, tapes, discs, programs and software, downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing, and organizing electronic games, and electronic games downloadable via the internet and mobile devices and video games, namely video game cartridges, discs and software, **all relating to motion pictures and entertainment concerning motion pictures**” in Class 9 (emphasis added).

A. PRELIMINARY STATEMENT

Applicant is the well-known producer and distributor behind the enormously successful motion pictures *The Divergent Series: Divergent*, *The Divergent Series: Insurgent*¹ and to-be-released films *The Divergent Series: Allegiant* and *The Divergent Series: Ascendant* (collectively, the “*Divergent* Motion Pictures”). (Office Action Response, May 5, 2014 at 4.) In connection with its successful franchise, Applicant seeks registration of the mark INSURGENT for various goods in Class 9. Indeed, Applicant’s use of its INSURGENT mark refers to the second of these films. (*Id.*)

Registrant Blum is an individual who offers computer game software. (*Id.* at 5.)

¹ Applicant’s film *Insurgent* was released globally throughout theaters in March 2015, which fell between Applicant’s submission of evidence in its Request for Reconsideration filed on December 5, 2014 and the present appeal brief.

The Examiner refused registration of Applicant's INSURGENT mark on the ground that it is likely to be confused with the Cited Mark. When one also considers the weakness of the Cited Mark, the differences between the parties' marks, and the different contexts in which the parties' marks are encountered, among other factors, it is clear that consumers are unlikely to confuse Applicant's mark with the Cited Mark.

For the reasons given in Applicant's Office Action Response dated May 5, 2014, its Request for Reconsideration dated December 5, 2014, and all other filings Applicant has made for this application, all of which are expressly incorporated herein by reference, Applicant respectfully maintains that the refusal to register Applicant's INSURGENT mark is misplaced. The Board should reverse the Examiner's refusal to register Applicant's INSURGENT mark and allow the present application to proceed to publication.

B. STATEMENT OF FACTS

For the Board's convenience, the facts are summarized below.

1. Information About The Parties

As explained above, Applicant is the well-known producer and distributor behind the enormously successful *Divergent* Motion Pictures, based on the young adult science fiction book trilogy written by author Veronica Roth. (Office Action Response, May 5, 2014, Exs. A-B.)

In contrast, Registrant Blum is a U.S. citizen residing in Denver, Colorado who offers a computer game. (Office Action, April 17, 2013.)

2. Procedural Background

Applicant filed its application to register INSURGENT on January 1, 2013. Applicant filed its application under Section 1(b) of the Lanham Act for "Backpacks adapted for holding computers; cameras; camcorders; cell phones; computer games, namely, computer game cartridges, cassettes, tapes, discs, programs and software; blank USB flash drives; flash drives

containing prerecorded content relating to motion pictures, television programs, and literary works; decorative charms for cell phones; decorative magnets; decorative switch plate covers; digital media, namely, downloadable audio files featuring films, music and entertainment; digital photo frames; digital trading cards in the nature of multimedia software recorded on magnetic media featuring films, music and entertainment; downloadable computer wallpaper and screen saver software; downloadable files containing images relating to motion pictures, television programs, music and documentaries; downloadable electronic publications in the nature of songbooks, tablature, and sheet music; downloadable software that provides access to movie and entertainment-related content and allows users to socialize and interact with other users; downloadable television programs and documentaries featuring drama, comedy, horror, romance, and variety provided via a global computer network or video-on-demand service; downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing text, data, images, audio files, video files and electronic games; electric door bells; electronic diaries; electronic games downloadable via the internet and mobile devices; eyeglasses and eyeglass cases; GPS navigation devices; graduated rulers; headphones and earphones; laptop computers; magnetically encoded debit or credit cards; motion picture films in the fields of drama and romance; mouse pads; musical sound recordings; neon signs; personal digital assistants; portable media players; pre-recorded DVDs, videotapes, and other audiovisual recordings featuring motion pictures, music, television programs, and documentaries; cases, covers or sleeves for electronic apparatus, namely, cameras, camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cameras,

camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; sunglasses and sunglass cases; tablet computers; tape measures; and video games, namely, video game cartridges, discs and software” in Class 9.

On April 17, 2013, the Examiner suspended this application pending the disposition of prior filed U.S. Application Serial No. 85/032,335 for the mark INSURGENCY for “computer game software for personal computers and home video game consoles” in Class 9 owned by Blum. (Notice of Suspension, April 17, 2013 at 1.)

U.S. Application Serial No. 85/032,335 issued as U.S. Registration No. 4,392,625, namely, the Cited Mark, on August 27, 2013.

On November 6, 2013, the Examiner issued an Office Action refusing registration of Applicant’s mark based on a likelihood of confusion with newly registered U.S. Registration No. 4,392,625 (Office Action, November 6, 2013 at 1.) The Examiner’s refusal to register only applied to “computer games, namely computer game cartridges, cassettes, tapes, discs, programs and software, downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing, and organizing electronic games, and electronic games downloadable via the internet and mobile devices and video games, namely video game cartridges, discs and software.” (“Refused Goods”). (*Id.*)

Applicant filed its response to the Office Action on May 5, 2014 arguing that Applicant’s mark was distinguishable from the Cited Mark. (Office Action Response, May 5, 2014.) Applicant pointed out the weakness of the Cited Mark, the significant dissimilarities in the appearance, sound, connotation and commercial impressions between Applicant’s mark and the Cited Mark, as well as the different contexts in which the marks are encountered, the differences

between the goods offered under the respective marks, the differences in the purchasing conditions, the sophistication of Registrant's consumers, and the lack of fame of the Cited Mark.

On June 6, 2014, the Examiner issued a final Office Action refusing registration of Applicant's mark on likelihood of confusion grounds based on the Cited Mark. (Office Action, June 6, 2014.) The Examiner maintained his position that Applicant's mark and the Cited Mark were highly similar and that Applicant's goods and Registrant's goods were related. (*Id.* at 2-4.) The Examiner also disregarded Applicant's evidence supporting the weakness of the Cited Mark and the sophistication of the relevant consumers. (*Id.* at 3.) The Examiner stated that Applicant must respond to the final Office Action or the Refused Goods would be deleted from the application and the application would proceed for the remaining goods. (*Id.* at 5.)

Applicant responded to the Examiner's June 6, 2014 final refusal by filing a Request for Reconsideration on December 5, 2014. (Request for Reconsideration, December 5, 2014.) Applicant explained again why the connotations and commercial impressions of Applicant's mark and the Cited Mark are dissimilar. (*Id.* at 2-3.) Applicant also provided evidence that Applicant's goods and Registrant's goods would not be marketed in the same way. (*Id.* at 4-5.)

Finally, to preserve its rights, Applicant also filed a Notice of Appeal concurrently with its Request for Reconsideration.

On December 17, 2014, the Examiner denied Applicant's Request for Reconsideration on the ground that Applicant's mark was likely to be confused with the Cited Mark. (Office Action, December 17, 2014 at 1.)

On March 20, 2015, Applicant requested remand of this application. (Request for Remand, March 20, 2015.) Applicant filed a Request to Divide concurrently with its Request for Remand, requesting the PTO to divide out the non-refused goods into a child application,

namely, “Backpacks adapted for holding computers; cameras; camcorders; cell phones; blank USB flash drives; flash drives containing prerecorded content relating to motion pictures, television programs, and literary works; decorative charms for cell phones; decorative magnets; decorative switch plate covers; digital media, namely, downloadable audio files featuring films, music and entertainment; digital photo frames; digital trading cards in the nature of multimedia software recorded on magnetic media featuring films, music and entertainment; downloadable computer wallpaper and screen saver software; downloadable files containing images relating to motion pictures, television programs, music and documentaries; downloadable electronic publications in the nature of songbooks, tablature, and sheet music; downloadable software that provides access to movie and entertainment-related content and allows users to socialize and interact with other users; downloadable television programs and documentaries featuring drama, comedy, horror, romance, and variety provided via a global computer network or video-on-demand service; downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing text, data, images, audio files and video files; electric door bells; electronic diaries; eyeglasses and eyeglass cases; GPS navigation devices; graduated rulers; headphones and earphones; laptop computers; magnetically encoded debit or credit cards; motion picture films in the fields of drama and romance; mouse pads; musical sound recordings; neon signs; personal digital assistants; portable media players. pre-recorded DVDs, videotapes, and other audiovisual recordings featuring motion pictures, music, television programs, and documentaries; cases, covers or sleeves for electronic apparatus, namely, cameras, camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; fitted plastic films known as skins for covering and protecting electronic apparatus,

namely, cameras, camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; sunglasses and sunglass cases; tablet computers; and tape measures”. (Request to Divide, March 20, 2015.)

Applicant also filed an Amendment of Application concurrently with its Request for Remand and its Request to Divide, requesting a limiting amendment of the identification of goods in the parent application containing the Refused Goods to:

Computer games, namely, computer game cartridges, cassettes, tapes, discs, programs and software; downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing electronic games; electronic games downloadable via the internet and mobile devices; video games, namely, video game cartridges, discs and software, all relating to motion pictures and entertainment concerning motion pictures.

(Amendment of Application, March 20, 2015.)

On August 5, 2015, the Intent to Use Division of the PTO granted the Request to Divide and the Board notified Applicant that the non-refused goods in child Application Serial No. 85/983,745 had been forwarded for further processing towards registration. (TTAB Docket No. 9.)

As a result on August 28, 2015, the Board ordered that proceedings before the Board resume, allowing Applicant sixty days to file its appeal brief. (TTAB Docket No. 9.) This appeal brief is timely filed.

To date, Applicant’s request to amend the identification of goods has not yet been acted upon by the Examiner. Applicant assumes for purposes of this appeal brief that the amended identification of goods will be duly entered by the Examiner.

C. THE EXAMINER’S REFUSAL TO REGISTER APPLICANT’S MARK ON THE BASIS OF LIKELIHOOD OF CONFUSION SHOULD BE WITHDRAWN

The Examiner’s refusal to register Applicant’s mark is based solely on the ground that it is likely to be confused with the Cited Mark. As explained below, Applicant respectfully maintains that there is no likelihood of confusion between Applicant’s mark and the Cited Mark.

1. The Standard for Determining Likelihood of Confusion

To determine whether likelihood of confusion exists, the Examiner must consider *all* of the *DuPont* factors that are relevant to a particular case. *See In re E.I. Du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973); *see also Recot, Inc. v. Becton*, 214 F.3d 1322, 1326 (Fed. Cir. 2000) (whether likelihood of confusion exists is determined “on a case-specific basis” using the *DuPont* factors). An analysis of these factors demonstrates that there is no likelihood of confusion between Applicant’s mark and the Cited Mark.

The Office bears the burden of showing that a mark falls within the statutory bars of Section 2(d). J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fourth Ed.) § 19:75 at 19-230. To refuse registration under Section 2(d), the Examiner “must present sufficient evidence and argument that the mark is barred from registration.” *Id.* § 19:128 at 19-383. Here, and respectfully, the Examiner has not met his burden.

2. The Office Has a History of Registering Numerous INSURGENT and INSURGENT-Related Marks

DuPont and TMEP § 1207.01 advise that the nature and number of similar marks must be considered as a factor in determining likelihood of confusion. Indeed, the relative strength or weakness of a mark is “a very important element” in determining likelihood of confusion. *See McCarthy* § 23:48 at 23-203 (“If the common element of conflicting marks is a word that is ‘weak’ then this reduces the likelihood of confusion.”). The Board and courts routinely hold

that, “[t]he greater the number of identical or more or less similar marks already in use on different kinds of goods, the less is the likelihood of confusion between any two specific uses of the weak mark.” *First Sav. Bank, F.S.B. v. First Bank Sys.*, 101 F.3d 645, 653-54 (10th Cir. 1996); *see also Keebler Co. v. Associated Biscuits, Ltd.*, 207 USPQ 1034, 1038 (TTAB 1980) (citing the plethora of marks registered by the Office and incorporating the term CLUB as evidence supporting the Board’s finding that such marks were “entitled to only a very circumscribed scope of protection limited to essentially the same mark for essentially the same goods.”); *Sand Hill Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F. Supp.2d 1107, 1119 (N.D. Cal. 2010) (citation omitted) (“Where [, as here,] the market is inundated by products using the particular trademarked word, there is a corresponding likelihood that consumers ‘will not likely be confused by any two in the crowd.’”). Indeed, “[d]etermining that a mark is weak means that consumer confusion has been found unlikely because the mark’s components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related.” *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626 (8th Cir. 1987).

The Cited Mark is weak and therefore consumer confusion with Applicant’s mark is unlikely. Supporting this conclusion is the fact that the Office has a history of registering other INSURGENT and INSURGENT-related marks:

Reg. No.	Mark	Class and Goods/Services
3,767,162	THE INSURGENCY	Class 41: Audio recording and production; composition of music for others; consultation and advice regarding musical selections and arrangements for sound recordings and live performances; music composition and transcription for others; music composition for others; music production services; music publishing services; music transcription for others.
3,683,158	MORELES INSURGENTE	Class 31: Fresh beans; fresh lentils

Reg. No.	Mark	Class and Goods/Services
3,338,702	INSURGENTES WILDERNESS GRUPPO	Class 28: Collectable toy figures

(Office Action Response, May 5, 2014, Ex. J.)

The fact that the Office has registered such other INSURGENT marks indicates that the Office considers this mark weak and only entitled to a narrow scope of protection. Applicant maintains that the INSURGENT mark is weak and thus that consumer confusion is unlikely.

In response to this argument, the Examiner stated that evidence of third party registrations is not entitled to significant weight because the weakness or dilution of a particular mark is “generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods. (Office Action, June 6, 2014 at 3, original emphasis.) First, the Examiner’s attempt to characterize Applicant’s goods as different from the registrants’ goods are without merit. The fact remains that there are other third-party registrations for marks consisting of or including INSURGENT in the marketplace. This indicates that confusion is unlikely, particularly since Applicant’s INSURGENT mark is associated with the second motion picture in Applicant’s *Divergent* Motion Pictures and Applicant restricted its identification of the Refused Goods to “relating to motion pictures and entertainment concerning motion pictures”.

Second, the Federal Circuit has noted that third-party registrations incorporating a particular term can serve to negate a claim of exclusive rights in the term. *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 1565 n.1 (Fed. Cir. 1987). Furthermore, “a pattern of registrations” by third parties can suggest that businesses in different industries “believe that their respective goods are distinct enough that confusion between even identical marks is unlikely.” *In re Thor Tech, Inc.*, 113 USPQ.2d 1546, 1549 (TTAB 2015); *Keebler*, 207 USPQ at 1038 (finding that “registrations tend to define fields of use and, conversely, the boundaries of

use and protection surrounding the marks and marks comprising the same word ... for their various products. The mutual respect and restraint exhibited toward each other by the owners of the plethora of marks, evidenced by their coexistence on the Register, are akin to the opinion manifested by knowledgeable businessmen ...”) Furthermore, third-party registrations can show that a commonly registered term has a suggestive or descriptive significance for particular goods such that differences in the remaining portions of the marks may be sufficient to render the marks as a whole distinguishable. *See Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ.2d 1163, 1173 (TTAB 2011). In *Top Tobacco*, the applicant submitted several third-party registrations for marks incorporating the term “Classic” in connection with tobacco products to show weakness of the opposer’s asserted mark CLASSIC CANADIAN for tobacco. The Board found that opposer’s mark was entitled to only a narrow scope of protection, and that use of the term “Classic” in competing marks would be a weak basis for asserting likelihood of confusion:

The fact that the USPTO has allowed so many registrations for the tobacco-related goods containing a shared term to co-exist on the Principal register may be used “to establish that [the] portion common to the marks involved in a proceeding has a normally understood and well-known meaning [and] that this has been recognized by the [USPTO]...; and that therefore the inclusion of [the shared term] in each mark may be an insufficient basis on which to predicate a holding of confusing similarity.”

Top Tobacco, 101 USPQ.2d at 1173 (quoting *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ.2d 1404, 1406 (TTAB 1988)).

Just as in *Thor Tech*, and *Keebler*, the fact that the Office has registered other marks consisting of or incorporating INSURGENT indicates that it considers Registrant’s mark so widely used that the public easily distinguishes slight differences in the goods to which the marks are applied, even though the goods of the parties may be considered “related.” The same result should be reached here.

3. The Marks are Distinguishable in Appearance, Sound, Connotation and Commercial Impression and the Different Contexts in Which the Marks are Encountered

a. Applicant's Mark and the Cited Mark Are Encountered in Different Contexts

The courts and the Board routinely hold that there is no likelihood of confusion “if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source . . .” TMEP § 1207.01(a)(i) (emphasis added) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ.2d 1156, 1158 (TTAB 1990) (“[A]s far as the general public is concerned confusion would not be likely because the goods and services are sold through different channels of trade to different classes of consumers.”). In this case, confusion is unlikely because of the lack of similarity between the parties’ commercial activities, as well as the absence of common ground between their channels of trade.

As previously stated, Applicant’s mark INSURGENT refers to the second film in the immensely popular *Divergent* movie franchise. (Office Action Response, May 5, 2014, Ex. A.) The films are based on the enormously successful young adult science fiction book trilogy written by the author Veronica Roth, which have the same titles (“*Divergent* Series”). (*Id.*, Ex. B.) The *Divergent* Series is set place in a fictional dystopian post-apocalyptic Chicago, in which people are divided into factions based on human virtues. (*Id.*) The books and films focus on the story of a young girl and her unique ability to fit into all factions. (*Id.*)

Applicant’s first film, *Divergent*, has garnered U.S. sales of at least \$150 million and worldwide sales of at least \$288 million. (Request for Reconsideration, December 5, 2014, Ex.

C.) The *Divergent* film also became “the biggest advance ticket seller on [online ticket seller] Fandango, surpassing [Applicant] Summit Entertainment’s 2008 film *Twilight*.” (Office Action Response, May 5, 2014, Ex. D.) Applicant’s proposed use of its INSURGENT mark therefore refers to the second of these films, which is based on the second book in the *Divergent* Series. (*Id.*, Ex. E.) Applicant’s second film, *Insurgent*, was projected to gross between \$350 to \$400 million worldwide.² (Request for Reconsideration, December 5, 2014, Ex. B.)

Furthermore, Applicant’s INSURGENT mark for computer games and electronic games is only one facet of an overall brand built around the mark INSURGENT. Applicant has applied for and intends to use the INSURGENT mark for a broad array of merchandise, including stationery, clothing, magnets, cell phone covers, DVDs and CDs. The Office has already approved registration of Applicant’s mark INSURGENT in Classes 16 and 25, as well as certain goods in Classes 9 and 41. (Request for Reconsideration, December 5, 2014, Ex. F.) The Office has also approved registration of Applicant’s applications for DIVERGENT and ALLEGIANT in Classes 9, 16, 25 and 41. (*Id.*, Exs. G-H.) Applicant’s use of the DIVERGENT and ALLEGIANT marks refers to the first and third films of the *Divergent* Motion Pictures, respectively.

Ser. No.	Mark	Class and Goods/Services
85/983,745	INSURGENT	Class 9: Backpacks adapted for holding computers; cameras; camcorders; cell phones; blank USB flash drives; flash drives containing prerecorded content relating to motion pictures, television programs, and literary works; decorative charms for cell phones; decorative magnets; decorative switch plate covers; digital median namely, downloadable audio files featuring films, music and entertainment; digital photo frames; digital trading cards in then mature of multimedia software recorded on magnetic media featuring films, music and entertainment; downloadable computer wallpaper and screen saver software; downloadable files containing images relating to motion

² Applicant’s film *Insurgent* was released globally throughout theaters in March 2015, which fell between Applicant’s submission of evidence in its Request for Reconsideration filed on December 5, 2014 and the present appeal brief.

Ser. No.	Mark	Class and Goods/Services
		<p>pictures, television programs, music and documentaries; downloadable electronic publications in the nature of songbooks, tabulator, and sheet music; downloadable software that provides access to movie and entertainment-related content and allows users to socialize and interact with other users; downloadable television programs and documentaries featuring drama, comedy, horror, romance, and variety provided via a global computer network or video-on-demand service; downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing text, data, images, audio files and video files; electric door bells; electronic diaries; eyeglasses and eyeglass cases; GPS navigation devices; graduated rulers; headphones and earphones; laptop computers; magnetically encoded debit or credit cards; motion picture films in the fields of drama and romance; mouse pads; musical sound recordings; neon signs; personal digital assistants; portable media players. pre-recorded DVDs, videotapes, and other audiovisual recordings featuring motion pictures, music, television programs, and documentaries; cases, covers or sleeves for electronic apparatus, namely, cameras, camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cameras, camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; sunglasses and sunglass cases; tablet computers; and tape measure</p>
85/813,594	INSURGENT	<p>Class 16: Adhesive tape for stationery or household purposes, address books, appointment books, art papers, art pictures, baby bibs of paper, banners of paper, binders, blank journals, book covers, bookends, bookmarks, books in the field of entertainment, calendars, chalk, chalk boards for school and home use, coloring books, clipboards, decays, decorative paper bows for wrapping, decorative paper centerpieces, desktop organizers, dry erase writing boards and writing surfaces, erasers, file folders, framed art prints, non-magnetically encoded gift cards, paper gift cards, gift bags, gift wrapping paper, greeting cards, journals concerning entertainment, lithographs, magazines in the field of entertainment, money clips, note cards, note pads with or without adhesive, notebooks, paper bags, paper banners, paper coasters, paper emblems, paper flags, paper labels, paper napkins, paper party decorations, paper place mats, paperweights, photographs with or without autographs, writing instruments, cases for writing instruments, photo albums, photo books, photographs mounted as life-size cardboard cutouts, postcards, poster books, posters, printed paper signs in the nature of door hangers, rubber stamps, scrapbook albums, scrapbooks, sheet music, songbooks, stationery, stickers, temporary tattoos, and trading cards; kits containing activity supplies, namely, sticker books, decorative magnets and figurines featuring</p>

Ser. No.	Mark	Class and Goods/Services
		fictional characters; kits containing party supplies, namely, paper napkins, plastic utensils, namely, forks, spoons and knives and paper or plastic plates, cups, table covers, and paper party decorations
85/813,595	INSURGENT	Class 25: Clothing, namely, aprons, bandanas, dresses, gloves, hooded shirts, infantwear, jackets, jerseys, leggings, loungewear, mittens, mock turtle neck shirts, neckties, pants, ponchos, scarves, shirts, shorts, skirts, sleepwear, socks, suits, sweaters, sweatpants, sweatshirts, t-shirts, tank tops, track pants, track suits, tunics, undergarments, vests, wind resistant jackets, yoga pants, and outerwear in the nature of wraps; wrist bands made of cloth, leather, or imitation leather; belts; footwear; and headwear
85/976,179	INSURGENT	Class 41: Entertainment in the nature of ongoing dramatic television programs; providing information relating to television programs; providing a website featuring information on television programs; production and distribution of motion pictures; providing information relating to motion pictures and literary works; providing a website featuring information on motion pictures, literary works and music; fan clubs; organization of fan conventions in the field of entertainment
85/813,584	DIVERGENT	Class 9: Backpacks adapted for holding computers; cameras; camcorders; cell phones; computer games, namely, computer game cartridges, cassettes, tapes, discs, programs and software; blank USB flash drives; flash drives containing prerecorded content relating to motion pictures, television programs, and literary works; decorative charms for cell phones; decorative magnets; decorative switch plate covers; digital media, namely, downloadable audio files featuring films, music and entertainment; digital photo frames; digital trading cards in the nature of multimedia software recorded on magnetic media featuring films, music and entertainment; downloadable computer wallpaper and screen saver software; downloadable files containing images relating to motion pictures, television programs, music and documentaries; downloadable electronic publications in the nature of songbooks, tablature, and sheet music; downloadable software that provides access to movie and entertainment-related content and allows users to socialize and interact with other users; downloadable television programs and documentaries featuring drama, comedy, horror, romance, and variety provided via a global computer network or video-on-demand service; downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing text, data, images, audio files, video files and electronic games; electric door bells; electronic diaries; electronic games downloadable via the internet and mobile devices; eyeglasses and eyeglass cases; GPS navigation devices; graduated rulers; headphones and earphones; laptop computers; magnetically encoded debit or credit cards; motion picture films in the fields of drama and romance; mouse pads; musical sound recordings; neon signs; personal digital assistants; portable media players. pre-recorded DVDs, videotapes, and other audiovisual

Ser. No.	Mark	Class and Goods/Services
		recordings featuring motion pictures, music, television programs, and documentaries; cases, covers or sleeves for electronic apparatus, namely, cameras, camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cameras, camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; sunglasses and sunglass cases; tablet computers; tape measures; and video games, namely, video game cartridges, discs and software
85/813,585	DIVERGENT	Class 16: Adhesive tape for stationery or household purposes, address books, appointment books, art papers, art pictures, baby bibs of paper, banners of paper, binders, blank journals, book covers, bookends, bookmarks, books in the field of entertainment, calendars, chalk, chalk boards for school and home use, coloring books, clipboards, decals, decorative paper bows for wrapping, decorative paper centerpieces, desktop organizers, dry erase writing boards and writing surfaces, erasers, file folders, framed art prints, non-magnetically encoded gift cards, paper gift cards, gift bags, gift wrapping paper, greeting cards, journals concerning entertainment, lithographs, magazines in the field of entertainment, money clips, note cards, note pads with or without adhesive, notebooks, paper bags, paper banners, paper coasters, paper emblems, paper flags, paper labels, paper napkins, paper party decorations, paper place mats, paperweights, photographs with or without autographs, writing instruments, cases for writing instruments, photo albums, photo books, photographs mounted as life-size cardboard cutouts, postcards, poster books, posters, printed paper signs in the nature of door hangers, rubber stamps, scrapbook albums, scrapbooks, sheet music, songbooks, stationery, stickers, temporary tattoos, and trading cards; kits containing activity supplies, namely, sticker books, decorative magnets and figurines featuring fictional characters; kits containing party supplies, namely, paper napkins, plastic utensils, namely, forks, spoons and knives sandpaper or plastic plates, cups, table covers, and paper party decorations
85/813,586	DIVERGENT	Class 25: Clothing, namely, aprons, bandanas, dresses, gloves, hooded shirts, infantwear, jackets, jerseys, leggings, loungewear, mittens, mock turtle neck shirts, neckties, pants, ponchos, scarves, shirts, shorts, skirts, sleepwear, socks, suits, sweaters, sweatpants, sweatshirts, t-shirts, tank tops, track pants, track suits, tunics, undergarments, vests, wind resistant jackets, yoga pants, and outerwear in the nature of wraps; wrist bands made of cloth, leather, or imitation leather; belts; footwear; and headwear
85/813,587	DIVERGENT	Class 41: Entertainment in the nature of ongoing dramatic television programs; providing information relating to television programs; providing a website featuring information on television programs; providing online computer games; production and distribution of motion pictures; providing

Ser. No.	Mark	Class and Goods/Services
		information relating to motion pictures and literary works; providing a website featuring information on motion pictures, literary works and music; fan clubs; organization of fan conventions in the field of entertainment
86/061,524	ALLEGIANT	Class 9: Backpacks adapted for holding computers; battery chargers for use with mobile phones; blank USB flash drives; cameras; camcorders; cases or sleeves for portable electronic devices, namely, cell phones, PDAs, tablet computers, e-book readers, and music players; cell phones; computer game cartridges, discs, and software; covers or fitted vinyl films known as skins for covering and protecting headphones, speakers, and portable electronic devices, namely, cell phones, PDAs, media players, laptop computers, tablet computers, e-book readers, GPS units, computer accessories and peripherals, cameras, and camcorders; decorative charms for cell phones; decorative magnets; decorative switch plate covers; digital music downloadable from the internet; digital photo frames; downloadable computer wallpaper or screen saver software; downloadable electronic game programs; downloadable files containing audio and video content relating to motion pictures, television programs, documentaries, and music; downloadable files containing images relating to motion pictures, television programs, documentaries, and music; downloadable graphics; downloadable podcasts in the field of entertainment; downloadable ringtones; downloadable software that provides access to movie and entertainment-related content and allows users to socialize and interact with other users; electronic diaries; electronic game software; electronic publications in the nature of songbooks, tablature, and sheet music, sold on pre-recorded digital media or downloadable via the internet; electronic publications in the nature of books, magazines, journals, brochures, and newsletters, all in the field of music, and subject matters generally related to entertainment; eyeglasses; eyeglass cases; GPS navigation devices; graduated rulers; headphones or earphones; laptop computers; magnetically encoded debit or credit cards, magnetically encoded gift cards; motion picture films featuring drama, comedy, horror, romance, and science fiction; mouse pads; musical sound recordings; musical video recordings; neon signs; personal digital assistants; portable media players; pre-recorded electronic media featuring and promoting motion pictures, television programs, documentaries, literary works, music; sunglasses; sunglass cases; tablet computers; USB flash drives sold with pre-recorded entertainment content featuring and promoting motion pictures, television programs, documentaries, literary works, music; USB power banks for charging multiple devices simultaneously; video games, namely, video game cartridges, cassettes, discs and software
86/061,525	ALLEGIANT	Class 16: Address books; adhesive tape for stationery or household purposes; appointment books; art papers; art pictures; baby bibs of paper; banners of paper; binders; blank journals; book covers; bookends; bookmarks; books in the field of

Ser. No.	Mark	Class and Goods/Services
		entertainment; calendars; chalk boards for school and home use; chalk; clipboards; coloring books; concert programs; decals; decorative paper bows for wrapping; decorative paper centerpieces; desktop organizers; dry erase writing surfaces; erasers; folders; framed art prints; gift bags; gift cards without magnetic encoding; gift wrapping paper; greeting cards; iron-on transfers; lithographs; magazines in the field of entertainment; money clips; note cards; note pads with or without adhesive; notebooks; novelty wine and beer labels; paper bags; paper banners; paper coasters; paper emblems; paper flags; paper labels; paper napkins; paper party decorations; paper place mats; paperweights; pencil cases; pencil sharpeners; photo albums; photo books; photographs mounted as life-size cardboard cutouts; photographs with or without autographs; postcards; posters; printed paper signs in the nature of door hangers; rubber stamps; scrapbooks; sheet music; songbooks; stationery; stickers; temporary tattoos; trading cards; writing instruments; kits containing party supplies, namely, paper napkins, plastic utensils, namely, forks, spoons and knives and paper or plastic plates, cups, table covers, and paper party decorations
86/061,526	ALLEGIANT	Class 25: Aprons; bandanas; baby bibs not of paper; costumes for Halloween or for use in role-playing games; do rags; dresses; hooded shirts; infantwear; jackets; jerseys; leggings; loungewear; maternity shirts; mittens or gloves; neckwear; outerwear in the nature of wraps; pants; ponchos; scarves; shirts; shorts; skirts; skorts; sleepwear; socks; suits; sweaters; sweatpants; sweatshirts; swimwear; t-shirts; tank tops; track pants; track suits; tunics; undergarments; vests; wind resistant jackets; yoga pants; wrist bands made of cloth, leather or imitation leather; belts; footwear; headwear
86/061,527	ALLEGIANT	Class 41: Entertainment in the nature of ongoing dramatic television programs; entertainment services, namely, conducting contests; fan club services; online journals, namely, blogs relating to motion pictures, television programs, documentaries, music, and literary works; organization of fan conventions in the field of entertainment; production and distribution of motion pictures; providing information relating to motion pictures, television programs, documentaries, music, and literary works; providing a website featuring news, information and images relating to motion pictures, television programs, documentaries, music, and literary works; providing a website featuring non-downloadable, pre-recorded musical and dramatic performances; providing online computer games; providing podcasts relating to entertainment, namely motion pictures, television programs, documentaries, music, and literary works; providing pre-recorded, non-downloadable dramatic and musical performances relating motion pictures, television programs, documentaries, music, and literary works

(Office Action Response, May 5, 2014, Exs. F-H.)

Applicant's INSURGENT mark thus conveys a connotation and commercial impression uniquely associated with the *Insurgent* novel and the *Insurgent* motion picture, as well as the overall *Divergent* trilogy. In recognition of this marketplace reality, Applicant's identification of goods expressly contains a restriction, namely, they are all products "relating to motion pictures and entertainment concerning motion pictures". The Cited Mark does not contain any association with Applicant's *Divergent* Motion Pictures or the *INSURGENT* film, nor could it without infringing Applicant's rights in its *Divergent* Motion Picture franchise.

This is yet one more factor that weighs against any likelihood of confusion.

b. Applicant's Mark and the Cited Mark are Different in Appearance, Sound, Connotation and Commercial Impression

When determining likelihood of confusion, marks are compared in their entireties based the similarity or dissimilarity in sight, sound, connotation and commercial impression. *See DuPont*, 177 USPQ at 567. Applicant's mark INSURGENT is dissimilar from the Cited Mark in all respects.

First, Applicant's INSURGENT Mark and the Cited Mark INSURGENCY are visually different. Applicant's INSURGENT mark ends with the letter T while the Cited Mark ends with the different letters CY. Considering the other INSURGENT marks already on the federal register, this difference in spelling, even by one letter, is significant enough to distinguish Blum's INSURGENCY mark from Applicant's mark. *See, e.g., Echo Drain v. Newsted*, 307 F. Supp.2d 1116, 1126 (C.D. Cal. 2003) (no likelihood of confusion between ECHO DRAIN and ECHOBRAIN); *Colgate-Palmolive v. J.M.D. All-Star Import*, 486 F. Supp.2d 286, 290-91 (S.D.N.Y. 2007) (no likelihood of confusion between COLGATE and COLDDATE).

Applicant's mark and Registrant's mark also sound different. Applicant's mark consists of three syllables while the Cited Mark consists of four syllables. Such differences in appearance

and sound indicate that confusion is unlikely. *See, e.g., Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529, 530 (CCPA 1970) (“PEAK” and “PEAK PERIOD” both for toilet preparations, not likely to be confused); *Kayser-Roth Corp. v. Morris, Co., Inc.*, 164 USPQ 153, 153-54 (TTAB 1969) (“PAUL JONES ESQUIRE” and “ESQUIRE” not likely to be confused for apparel items).

Most importantly, the Examiner has only focused on the generic dictionary definitions of the words, rather than the meanings imbued through marketing and popular media. Applicant’s INSURGENT mark conveys a connotation and commercial impression uniquely associated with the *Insurgent* novel and the *Insurgent* motion picture, as well as the overall *Divergent* trilogy. Registrant’s mark INSURGENCY ends in CY rather than T and thus does not have the same association with the *Divergent* trilogy (DIVERGENTT, INSURGENTT, ALLEGIANTT) that Applicant’s mark INSURGENT does. Registrant’s video game under Registrant’s INSURGENCY mark is associated with multi-player infantry warfare game involving the U.S. Marines and terrorists, set in Iraq and Afghanistan. (Request for Reconsideration, December 5, 2014, Ex. C.) Given the nature of Registrant’s products, it appears that Registrant’s mark is associated with the Iraqi Insurgency which escalated after U.S. troops withdrew from Iraq in 2011. *See* [https://en.wikipedia.org/wiki/Iraqi_insurgency_\(2011%E2%80%9314\)](https://en.wikipedia.org/wiki/Iraqi_insurgency_(2011%E2%80%9314)).

In sum, Applicant’s mark is distinguishable from the Cited Mark based on differences between the appearance, sound, connotation, and commercial impression of the respective marks, as well as the different contexts in which the marks are encountered.

4. Applicant’s Goods and the Goods in Registered in Connection with the Cited Mark Are Not Related

The Examiner has consistently suggested that Applicant’s and Registrant’s goods are identical or highly related. (*See, e.g., Office Action*, November 6, 2013 at 3.) However, as

previously explained by Applicant, the Board has made clear that this is insufficient to find likelihood of confusion.

The marketplace reality clearly demonstrates that each party's respective goods are not "marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source". TMEP § 1207.01(a)(i). For example, in *Sunenblick v. Harrell*, the court found no confusion between jazz records and hip-hop records sold under the *identical mark* UPTOWN RECORDS because, although the recordings were both musical products, they were marketed to different consumers and sold in separate sections of record stores. *Sunenblick v. MCA Records, Inc.*, 895 F. Supp. 616, 629 (S.D.N.Y. 1995). *See also Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1095 (D.N.J. 1997) (HARLEM WIZARDS for showcase basketball team and WASHINGTON WIZARDS for professional basketball team not likely to be confused).

As explained above, Applicant's mark INSURGENT refers to the second film in the immensely popular epic science fiction dystopia movie franchise *Divergent*. It is not surprising, then, that fans of the *Divergent* Motion Pictures would wish to purchase goods bearing Applicant's mark. Applicant's computer and electronic games would be marketed in association with Applicant's *Insurgent* motion picture. Registrant's multiplayer tactical shooting/military game lacks that association. Because each party's respective goods are not "marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source," it is highly unlikely, if not impossible, that consumers would confuse Applicant's and Registrant's goods.

Furthermore, an internet search on search engine site Google for the term “Insurgent” only brings up hits for Applicant’s *Insurgent* film and not Registrant’s video game. (Request for Reconsideration, December 5, 2014, Ex. D.) Conversely, a Google search for the term “Insurgency” only brings up hits for Registrant’s video game and not Applicant’s film. (Request for Reconsideration, December 5, 2014, Ex. E.) Popular media references to “Insurgent” consistently directs viewers to Applicant’s *Insurgent* film and the *Divergent* Motion Pictures, including the cast of actors, the script, the trailer and other pertinent facts that fans are interested in. (Request for Reconsideration, December 5, 2014, Exs. F-K.) Individuals interested in the *Insurgent* film and the *Divergent* Motion Pictures are highly unlikely to confuse the science fiction dystopian plot premise with a multiplayer tactical shooting/military game that aims to recreate modern day war in Iraq and Afghanistan. Conversely, individuals interested in that multiplayer tactical/military game are highly unlikely to confuse modern day Afghanistan and Iraq with a fictional post-apocalyptic Chicago.

Finally, Applicant amended its identification of goods to expressly limit all the goods as those “relating to motion pictures and entertainment concerning motion pictures.” In other words, Applicant identified its goods’ connection and affiliation to the *Divergent* Motion Pictures and that the goods are marketed that way, thereby further distinguishing the respective products of Applicant and Registrant. The Board has recently held that “associated with” language in the identification of goods or services may be “precatory language, and not binding on consumers” when encountering a particular mark if the language does not alter the nature of the goods or represent that the goods will be marketed in any particular limited way, or through limited trade channels or to any particular class of consumers. *See In re i.am.symbolic, llc*, 2015 TTAB LEXIS 369,*10 (TTAB 2015). Applicant respectfully submits that the present limitation,

“relating to motion pictures and entertainment concerning motion pictures” contains a meaningful limitation that would be reflected in the relevant marketplace. Applicant’s restriction of its computer and electronic games in Class 9 to those “relating to motion pictures and entertainment concerning motion pictures” means that Applicant expressly states that its Refused Goods are limited to motion pictures and entertainment. Notably, Applicant would be precluded from renewing its registration of INSURGENT for computer and electronic games in Class 9 that do not relate to motion pictures and entertainment. Finally, Applicant’s marketing of its computer and electronic games in Class 9 must have a connection to motion pictures and entertainment in order to assert valid trademark registration rights in its mark. In other words, Applicant is bound by the language in its identification of the Refused Goods to advertise and sell goods that do in fact relate to motion pictures and entertainment concerning motion pictures. This in turn means that the relevant consumers will only encounter the Refused Goods from Applicant that are *Divergent* Motion Picture branded merchandise.

Applicant’s express limitation in its identification of the Refused Goods also negates any possibility of reverse confusion, that is, “the situation where a significantly larger or prominent newcomer ‘saturates’ the market’ with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services.” *In re i.am.symbolic, llc*, 2015 TTAB LEXIS 369, *12, citing *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 957 & n.12 (7th Cir. 1992), *cert. denied*, 507 U.S. 1042, 113 S. Ct. 1879, 123 L. Ed. 2d 497 (U.S. 1993). As discussed above, Applicant’s trademark rights in its INSURGENT mark for its computer and electronic games only arise in connection with *Divergent* Motion Picture branded merchandise. Thus, it cannot be said that Applicant’s goods are “related” to Registrant’s multiplayer tactical shooting/military game, which are not (and cannot be) branded as *Divergent*

Motion Picture merchandise nor can Registrant's products contain content from the *Divergent* Motion Pictures or be associated with such Motion Pictures without violating Applicant's rights associated with them.

This limitation in the identification of the Refused Goods weighs in favor of a finding that there is no likelihood of confusion between Applicant's mark and the Cited Mark.

5. Registrant's Customers Exercise Care

The *DuPont* test also considers the conditions under which and the buyers to whom sales are made, i.e. "impulse" buys vs. careful, sophisticated purchasing. See *DuPont*, 476 F.2d at 1361. There is always less likelihood of confusion where goods are purchased after careful consideration. See *Continental Plastic Containers v. Owens Brockway Plastic Products, Inc.*, 141 F.3d 1073, 1080 (Fed. Cir. 1998) (wholesale buyers of one gallon jugs of juice are sophisticated and not likely to be confused); *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992) "(Where the purchasers are the same, their sophistication is important and often dispositive because '[s]ophisticated consumers may be expected to exercise greater care.'"); *In re Digirad Corp.*, 45 USPQ.2d 1841, 1843 (TTAB 1998).

Registrant's customers are sophisticated video game players who are looking for the specific type of game, namely, a multiplayer tactical first person shooter game with an army combat theme set in Iraq and Afghanistan and in particular, the Iraqi Insurgency. Such customers are quite unlikely to confuse Registrant's video game with Applicant's games associated with the *Divergent* trilogy of motion pictures and books, which focuses on the life of a young girl and which are set in a fictional dystopian Chicago. See *In re Digirad Corp.*, 45 USPQ.2d 1841, 1843 (TTAB 1998) (threshold for confusion is much higher for careful, sophisticated, discriminating purchasers than for impulse purchasers, and there is always less

likelihood of confusion if the purchase concerns an expensive product or is made after careful examination of the product). Given the pervasiveness of video games, computer games and other electronic digital media, Registrant's consumers are savvy enough to study the titles before selecting or purchasing the games they wish to play. *See, e.g., M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 1383 (Fed. Cir. 2006) ("Moreover, given the pervasiveness of software and software-related goods in society, it would be inappropriate to presume relatedness on the mere basis of goods being delivered in the same media format, especially where, as here, the goods described in both the application and registration are defined narrowly, along distinct industry lines.")

Critic reviews and fan comments for Registrant's INSURGENCY video game consistently appear on websites focused on video games, computer games and other multi-player games, not movie sites or fan sites geared towards movies. (Request for Reconsideration, December 5, 2014, Exs. L-N.) The target audience for Registrant's INSURGENCY game are clearly different from that of Applicant's INSURGENT goods associated with Applicant's *Insurgent* film.

These purchasing conditions weigh in favor of a finding that there is no likelihood of confusion between Applicant's mark and the Cited Mark.

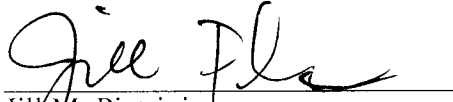
6. There is No Evidence the Cited Mark is Famous

The Examiner must also consider the fame of the Cited Mark. "Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark." *Recot*, 214 F.3d at 1327. In this case, the Examiner has offered no evidence that Registrant's INSURGENCY mark is famous or is likely to be remembered in the public mind, despite repeated opportunities to do so. This further demonstrates that confusion between Applicant's mark and the Cited Mark is unlikely.

D. CONCLUSION

For the reasons stated above, and in all of Applicant's other documents and evidence, Applicant respectfully requests that the Board reverse the decision of the Examiner and allow the mark to proceed to publication. Applicant requests oral argument and has separately filed a Request for Oral Argument.

Respectfully submitted,

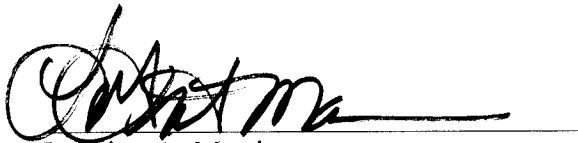


Dated: October 27, 2015

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on this 27th day of October, 2015.



LaTrina A. Martin

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